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REMARKS

Claims 1-26, 29-36, 38, 39 and 42-54 are pending in the subject application. Claims 1-9, 12, 16, 19-34, 41, 42, 46, 48-50, and 52 are amended, claims 56 and 57 are added, and claims 27 and 40 are canceled. The amendments are supported by the specification as filed, and no new matter is presented. Favorable reconsideration in light of the remarks which follow is respectfully requested.

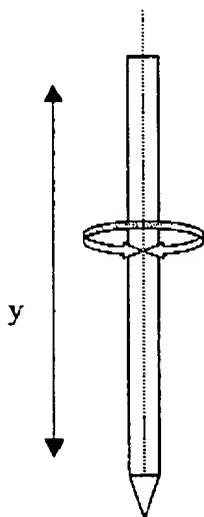
1. 35 U.S.C. §102 Rejection

Claims 1-26, 29-36, 38-39, 42, 43, 46 and 48-54 stand rejected under 35 U.S.C. §102(b) as being anticipated by Madhani et al (6,786,896). Applicants respectfully traverse.

Madhani at least fails to teach or suggest an apparatus for placing a proximal portion of a needle in a target area comprising (a) a first arm configured and arranged to rotatably support the needle about its translational axis, as recited in Applicants' independent claims 1, 16, 26, 29, and 42, (b) a second drive mechanism being coupled to the needle and being configured and arranged so as to cause the needle to rotate about translational axis of the needle, as recited in Applicants' independent claims 1, 26, and 42, and (c) a second drive mechanism comprising a gear member secured to the needle and being mechanically coupled to a motor such that operation of the motor causes the needle to rotate about its translational axis, as recited in Applicants' independent claim 26. Further, with respect to Applicants' independent claim 46, Madhani at least fails to teach or suggest a method wherein the needle is rotated about the translational axis of the needle.

As set forth by Applicants, the long axis of the needle is its translational axis (see page 5, lines 14-15). This is the axis that runs along the length of the needle (the needle represented below with the translational axis shown by the dotted line). Applicants' apparatus provides longitudinal motion of the penetrating member along its translational axis (as shown below by the arrow labeled y) and rotational motion about its translational axis (as shown below by the curved arrow).

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Madhani, on the other hand, describes a robotic apparatus having a base unit 302 and a wrist unit 304 (col. 10, lines 21-26). The apparatus has eight joints labeled 0-7, and the system is grounded through a U-shaped stationary base bracket 308, with spindle link 0 rotating with the base about axis 0 (col. 10, line 33-37; Figs. 1, 2, 3, 11, 12).

However, the tool shaft 312, which the Office compares to Applicants' penetrating member is not a needle in accordance with Applicants' claims. Rather, the tool shaft 312 provides a wrist 316 and jaws 318 at its distal end. Applicants further note that no other components of the Madhani device could be considered a needle in accordance with Applicants' disclosure. For example, even if the jaws 318 of the wrist unit 304 held a needle, it is clear from Figs. 11 and 12 that any member held by jaws 318 would be incapable of rotation about its own axis. The configuration of the wrist unit and jaws would prevent such rotation.

With respect to the Office's reference to Figure 3 and rotation about axis 0, Applicants respectfully submit that while this rotation is about axis 0, axis 0 does not correspond to the translational axis of the tool shaft 312 or any element of Madhani that could be considered a needle. Rather, this axis is provided in the base unit 302 and provides rotation of spindle link 0 within the base about axis 0 (see Figs. 1, 2, 3 and col. 10, lines 35-37).

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Thus, Madhani does not teach or suggest a device comprising a needle, wherein the needle is provided with longitudinal motion along its translational axis as well as rotation about its translational axis.

Accordingly, claims 1, 16, 26, 29, 42, and 46 are patentable over Madhani et al. Claims 2-15, 17-25, 27, 28, 30-36, 38, 39, 41, 43, and 48-54 depend from claims 1, 16, 26, 29, 42, and 46 and, likewise, are patentable over Madhani et al. Reconsideration and withdrawal of the rejection is respectfully requested.

2. Allowable Subject Matter

Applicants appreciate the notification in the Office Action of allowable subject matter, i.e. that claims 44-45 are allowed and that claims 27-28 and 40-41 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Applicant has added new independent claims 56 and 57 directed to claims 27 and 40, respectively.

CONCLUSION

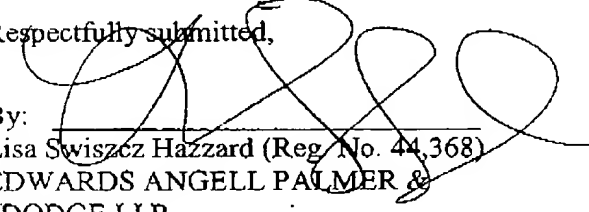
It is respectfully submitted that the subject application is in a condition for allowance. Early and favorable action is requested.

If for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, the Commissioner is hereby authorized and requested to charge Deposit Account No. 04-1105.

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Customer No. 21,874

Respectfully submitted,

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